

Page



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/921,955

08/03/2001

George Bilbrey

5797.02

8393

20686

7590

12/15/2004

DORSEY & WHITNEY, LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
370 SEVENTEENTH STREET  
SUITE 4700  
DENVER, CO 80202-5647

EXAMINER

CLARK, ISAAC R

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/921,955	<b>Applicant(s)</b> BILBREY ET AL.	
	<b>Examiner</b> Isaac R Clark	<b>Art Unit</b> 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-37 are presented for examination.

***Priority***

2. The applicant claims priority under 35 USC § 119(e) from Provisional Application No. 60/223,379 filed 08/07/2000 and Provisional Application No. 60/246,357 filed 11/07/2000.

***Drawings***

3. The Examiner contends that the drawings submitted on 05/18/2001 are acceptable for examination proceedings.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-11 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. As per claim 7, claim 7 recites the limitation "those requested by the at least one Sponsor database" in lines 13-14. There is insufficient antecedent basis for this limitation because only a single requested address is cited in lines 9 and 10.
7. Claims 8 and 9 are rejected because of their dependencies on claim 7.
8. As per claim 10, claim 10 recites the limitation "the request for an updated address" in line 7. There is insufficient antecedent basis for this limitation in the

Art Unit: 2154

claim because the claim recites "at least one request for an updated address" and it cannot be determined which of a plurality of requests the limitation refers to.

9. For the purpose of examining the claim, "the request for an updated address" is interpreted to refer to all of the requests made for an update address.

10. As per claim 11, claim 11 recites the limitation "the electronic message" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim because claim 10 recites the limitation "an electronic message" in both lines 2 and 3 of the claim. It is unclear whether the first or second of the two recitations in claim 10 are the antecedent for "the electronic message" in claim 11, or whether the two recitations in claim 10 are intended to refer to the same electronic message.

11. For the purposes of examining the claims, it is assumed that both recitations of "an electronic message" in claim 10 refer to the same electronic message.

12. As per claim 34, claim 34 recites the limitation "when the response from the old address is not timely received." This language makes the claim indefinite because the specification does not suggest any guidelines for determining whether a response in a given time period is a timely response.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

Art Unit: 2154

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 2, 12, 13, 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Reilly (US Patent 6,427,164).

15. As per claim 1, Reilly discloses a system for updating at least one database containing at least one address for a recipient of an electronic message to be sent from a Sponsor to the recipient, comprising:

at least one database containing a listing of at least one address associated with a recipient (Abstract; col. 3, lines 4-8); a clearing house (Fig. 2, item 300) containing a listing of an old address and a new address for at least one recipient (col. 9, lines 15-21; col. 6, lines 10-15) and a communications link for transferring data between the database and the clearing house (Fig 2; col. 6, lines 4-11); whereupon receiving a request from the at least one database for an updated address for a recipient, the clearing house is queried for an identification of addresses that match the request from the at least one database to the clearing house (col. 8, lines 15-21), and based upon a result of the query to the clearing house, the clearing house matches those addresses that have changed with those requested by the at least one database and communicates such matches to the at least one database (col. 8, lines 25-30); whereupon receipt of a record containing an updated address the at least one database updates its address list (Abstract; col. 9, lines 54-58).

Art Unit: 2154

16. As per claim 2, Reilly discloses the system of claim 1, wherein the at least one database is accessed by a Sponsor in order to communicate a message from the Sponsor to at least one recipient (claim 2; col. 9, lines 57-59).

17. As per claim 12, Reilly discloses a system for updating at least one address associated with a recipient for receiving an electronic message, comprising: a database containing a listing of at least one address associated with a recipient for receiving an electronic message (Abstract; col. 3, lines 4-8); and a clearing house (Fig. 2, item 300) for receiving and processing a query for a new address associated with an old address for the recipient; wherein the clearing house contains a listing of an old address and an associated new address for the recipient (col. 8, lines 40-49); and whereupon receiving the query, the clearing house compares the old address identified in the query with at least one old address provided in the listing and communicates a result of the identification to the database; the result providing, for at least one address matched during the comparison, an identification of a new address associated with the old address (col. 8, lines 40-49; col. 9, lines 51-58).

18. As per claim 13, Reilly discloses the system of claim 12, wherein the database is associated with a Sponsor (col. 9, lines 54-58; sponsor means any sending user).

19. As per claim 15, claim 15 is a method claim containing the same subject matter as claim 1. Claim 15 is rejected for the same reasons as claim 1.

20. As per claim 17, Reilly discloses a method for registering a change of address for a recipient via an electronic change of address system, comprising:

Art Unit: 2154

providing an electronic change of address service at a Network Server (Fig. 2 item 300); receiving an old address and a new address from a recipient; and establishing a data record at the Network Server (col. 8, lines 40-46); whereupon receipt of a request from a Sponsor for a new address for the recipient, the Network Server receives from the Sponsor an old address, performs a comparison of the old address from the Sponsor and the old address from the recipient and when a match occurs provides to the Sponsor the new address previously established as a data record at the Network Server (col. 8, lines 46-49; col. 9, lines 50-57).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 3-6, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (US Patent 6,427,164) in view of Nielsen (US Patent 6,405,243).

23. As per claim 3, Reilly teaches the system of claim 1, wherein the clearing house (Fig. 2 item 300) is provided on a Network Server (col. 6, lines 4-10).

24. Reilly does not explicitly teach that the address clearing house is provided by an online information provider.

25. Nielsen teaches that the address clearing house is provided by an online information provider (col. 3, lines 49-60; address server operated as a paid service to provide address updating and forwarding).

26. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Nielsen to have the address clearing house provided by an online information provider because they both deal with forwarding email to updated recipient email addresses. Furthermore, the teaching of Reilly to have the clearing house provided by an online provider would provide email address forwarding not subject to the whims of the recipient's old site which might consider email forwarding of non customers to be a low priority and would eliminate the need for unreliable multiple link forwarding chains when the recipient changes his address multiple times (Nielsen, col. 1, lines 35-46).

27. As per claim 4, Reilly teaches the system of claim 3, wherein the Network Server registers at least one recipient with an electronic change of address service provided by the online information provider (col. 3, lines 24-26).

28. As per claim 5, Reilly teaches the system of claim 3, wherein the Network Server may be accessed from more than one online site by a recipient desiring to update at least one address associated with the recipient (Fig. 2; showing server accessible from domain 1 and domain 2; col. 6, lines 4-11).

29. As per claim 6, Reilly teaches the system of claim 5, wherein the recipient provides to the Network Server at least one old address and at least one new



Art Unit: 2154

address (col. 6, lines 11-15; users may register old and new addresses directly with the forwarding server).

30. As per claim 14, Reilly teaches the system of claim 12 wherein the recipient has previously identified the old and new addresses (col. 6, lines 11-15; users may register old and new addresses directly with the forwarding server).

31. Reilly fails to explicitly disclose that the clearing house is associated with an online information provider.

32. Nielsen teaches that the address clearing house is provided by an online information provider (col. 3, lines 49-60; address server operated as a paid service to provide address updating and forwarding).

33. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Nielsen to have the address clearing house provided by an online information provider because they both deal with forwarding email to updated recipient email addresses. Furthermore, the teaching of Reilly to have the clearing house provided by an online provider would provide email address forwarding not subject to the whims of the recipient's old site which might consider email forwarding of non customers to be a low priority and would eliminate the need for unreliable multiple link forwarding chains when the recipient changes his address multiple times (Nielsen, col. 1, lines 35-46).

34. As per claim 16, Reilly teaches the method of claim 15, wherein the clearing-house is accessible via an Internet connection (col. 6, lines 4-10).

Art Unit: 2154

35. Reilly fails to explicitly teach that the clearing house is associated with an online information provider.

36. Nielsen teaches that the clearing house is associated with an online information provider (col. 3, lines 49-60; address server operated as a paid service to provide address updating and forwarding).

37. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Nielsen to have the address clearing house associated with an online information provider because they both deal with forwarding email to updated recipient email addresses. Furthermore, the teaching of Reilly to have the clearing house provided by an online provider would provide email address forwarding not subject to the whims of the recipient's old site which might consider email forwarding of non customers to be a low priority and would eliminate the need for unreliable multiple link forwarding chains when the recipient changes his address multiple times (Nielsen, col. 1, lines 35-46).

38. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly as applied to claims 17 above in view of Harari (US Published Application 2002/0016857).

39. As per claim 18, Reilly teaches the method of claim 17, wherein the step of receiving an old address and a new address from a recipient further comprises receiving the old and new address information at a Sponsor whereupon the Sponsor communicates the old address and the new address to the Network Server (col. 8, lines 26-29).

40. Reilly fails to explicitly teach that the old and new recipient addresses were entered received by entering them in a data entry field on a Sponsor web site.

41. Harari teaches providing updated contact information including email addresses via a form on a web page (Paragraph 0021).

42. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Harari to provide a web page at the Sponsor with a data entry form for entering the old and new email addresses because they both deal with providing automatic updates to contacts after changing email addresses. Furthermore, the teaching of Harari to provide a web based form with data entry fields would provide a user interface to facilitating reviewing, managing and updating personal contact information.

43. As per claim 20, Reilly fails to teach the method of claim 18 wherein the data entry field on the Sponsor web site further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server.

44. Harari teaches that the data entry field on the web site further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server (Fig 4, items 403; Paragraphs 0029 and 0030).

45. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Harari to provide a web page at the Sponsor with a data entry form allowing the user to designate at

least one of two or more Sponsors two receive updates address information because they both deal with providing automatic updates to contacts after changing email addresses. Furthermore, the teaching of Harari to allow selecting multiple Sponsors to receive or not receive updated email addresses would allow the recipient to automate the delivery of updated email addresses as the recipient changes addresses (Harari, Paragraphs 0005 and 0023).

46. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Harari as applied to claim 18 above, and further in view of Tsuei (US Patent 6,654,779).

47. As per claim 19, Reilly fails to teach the method of claim 18, wherein the data entry field on the Sponsor web site further comprises an opt-in selection by which the recipient may opt-in to providing the change of address information to the Network Server.

48. Tsuei teaches that the recipient registers his email address change with a sponsor and additionally indicates provides consent information indicating that he wants his or her address registered with the change of address server (col. 11, lines 34-41),

49. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Tsuei to provide a data entry field on the Sponsors web site that include an opt-in selection for providing the change of address information to the Network Server because they both deal with registering email address changes for recipients and providing the updated addresses to senders. Furthermore, the teaching of obtain customer

Art Unit: 2154

consent before providing the updated address to the address server allows recipients to chose whether his change of address is communicated to other senders or only to the sender at which he registers thus allowing recipients to manage their security and privacy (Tsuei, col. 11, lines 50-54).

50. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly as applied to claim 17 above, further in view of Chang (US Published Application 2001/0054041).

51. As per claim 21, Reilly fails to explicitly teach method of claim 17, wherein the step of receiving an old address and a new address from a recipient further comprises establishing a pop-up window on a recipient's web browser, whereupon entry of the old address and the new address into the pop-up window, the old address and the new address are directly communicated to the Network Server.

52. Chang teaches establishing a pop up window for entering changes to the user's profile and transmitting the profile information to a central server for distribution to selected contacts (Paragraph 0113).

53. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Chang to receiving an old address and a new address from a recipient by establishing a pop-up window on a recipient's web browser and upon entry of the old address and the new address into the pop-up window communicate the old address and the new address to the Network Server of Reilly because they both deal with distributing updates to personal information. Furthermore, the teaching of Chang to use a

Art Unit: 2154

pop-up window to collect information for transmitting to the central server would allow triggering the collection process when local changes to the user's address are detected thus further automating the update process (Chang, Paragraph 113).

54. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Chang as applied to claim 21 above, further in view Harari (US Published Application 2002/0016857).

55. As per claim 22, Reilly fails to explicitly teach the method of claim 21, wherein the pop-up window further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server.

56. Harari teaches that the data entry field on the web site further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server (Fig 4, items 403; Paragraphs 0029 and 0030).

57. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Harari to provide a web page at the Sponsor with a data entry form allowing the user to designate at least one of two or more Sponsors to receive updates address information because they both deal with providing automatic updates to contacts after changing email addresses. Furthermore, the teaching of Harari to allow selecting multiple Sponsors to receive or not receive updated email addresses would allow

the recipient to automate the delivery of updated email addresses as the recipient changes addresses (Harari, Paragraphs 0005 and 0023).

58. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly as applied to claim 17 above in view of 'Official Notice'.

59. As per claim 23, Reilly fails to teach method of claim 17, further comprising requiring a Sponsor, upon receiving the new address, to query the recipient as to whether the recipient desires to receive new messages from the Sponsor at the new address.

60. The Office takes 'Official Notice' that it is well known in the art to provide an opt-in option to request whether a recipient wishes to receive continued communications from a sender. It would have been obvious to one of ordinary skill in this art at the time the invention was made to require a Sponsor upon receiving the recipient's address to query the recipient as to whether he desires to receive new messages from the Sponsor because doing so would allow the recipient to reject messages that the recipient would consider to be unwanted.

61. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly as applied to claim 17 above in view of Schoeffler (US Published Application 2001/0049745).

62. As per claim 24, Reilly fails to teach the method of claim 17, further comprising: communicating a message from the Network Server to the recipient via at least one of the old address and the new address; and receiving a response to the message, wherein the response is generated by the recipient via the new address.

63. Schoeffler teaches communicating a message from the Network Server to the recipient via the new address; and receiving a response to the message, wherein the response is generated by the recipient via the new address (Paragraph 0045).

64. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Schoeffler because they both deal with forwarding email to a recipient at a new email address. Furthermore, the teaching of Schoeffler to receive a response from the new email address would allow the recipient the opportunity to elect whether the recipient wished to provide the new email address to the requester thus giving the recipient control over the privacy of the email address.

65. As per claim 25, Reilly teaches the method of claim 24, wherein the step of receiving an old address and a new address from a recipient further comprises establishing a data entry field on a Sponsor web site associated with the Sponsor, whereupon entry of the old address and the new address into the data entry field, the Sponsor communicates the old address and the new address to the Network Server (col. 8, lines 26-29).

66. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly as applied to claim 25 above, and further in view of Tsuei (US Patent 6,654,779).

67. As per claim 26, Reilly fails to teach the method of claim 25, wherein the data entry field on the Sponsor web site further comprises an opt-in selection by



which the recipient may opt-in to providing the change of address information to the Network Server.

68. Tsuei teaches that the recipient registers his email address change with a sponsor and additionally indicates provides consent information indicating that he wants his or her address registered with the change of address server (col. 11, lines 34-41).

69. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Tsuei to provide a data entry field on the Sponsors web site that include an opt-in selection for providing the change of address information to the Network Server because they both deal with registering email address changes for recipients and providing the updated addresses to senders. Furthermore, the teaching of obtain customer consent before providing the updated address to the address server allows recipients to chose whether his change of address is communicated to other senders or only to the sender at which he registers thus allowing recipients to manage their security and privacy (Tsuei, col. 11, lines 50-54):

70. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Schoeffler as applied to claim 25 above, further in view of Harari (US Published Application 2002/0016857).

71. As per claim 27, Reilly fails to explicitly teach the method of claim 25, wherein the data entry field on the Sponsor web site further comprises a listing of at least two Sponsors from which the recipient may designate at least one

Sponsor to receive the old address and the new address from the Network Server.

72. Harari teaches that the data entry field on the web site further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server (Fig 4, items 403; Paragraphs 0029 and 0030).

73. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Harari to provide a web page at the Sponsor with a data entry form allowing the user to designate at least one of two or more Sponsors to receive updates address information because they both deal with providing automatic updates to contacts after changing email addresses. Furthermore, the teaching of Harari to allow selecting multiple Sponsors to receive or not receive updated email addresses would allow the recipient to automate the delivery of updated email addresses as the recipient changes addresses (Harari, Paragraphs 0005 and 0023).

74. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Schoeffler as applied to claim 24 above, further in view of Harari (US Published Application 2002/0016857).

75. As per claim 28, Reilly fails to explicitly teach the method of claim 24, wherein the response to the message further comprises an indication from the recipient as to whether the recipient desires to utilize a streamlined approach for notifying at least one Sponsor of the new address.

Art Unit: 2154

76. Harari teaches the recipient electing a streamlined for notifying one or more contacts of an updated email address by automatically updating the records of the contacts when the recipient changes his address (Paragraph 0023-0024).

77. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Harari to include in the response from the recipient an indication that the recipient desires to use a streamlined approach for notifying Sponsors of his new address because they both deal with providing automatic updates to contacts after changing email addresses. Furthermore, the teaching of Harari to allow recipients to elect a streamlined approach would allow the recipient to automate the delivery of updated email addresses as the recipient changes addresses (Harari, Paragraphs 0005 and 0023).

78. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Schoeffler as applied to claim 24 above, further in view of Bliss et al. (US Patent 6,654,789) hereinafter Bliss.

79. As per claim 29, Reilly fails to teach the method of claim 24, wherein the response to the message further comprises an indication from the recipient as to whether the recipient desires to utilize a notification approach for notifying at least one Sponsor of the new address.

80. Bliss teaches a user elected option to require that the recipient be notified prior to releasing an updated email address to a requester (col. 3, lines 1-8).

Art Unit: 2154

81. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Bliss to require the recipient to respond indicating a desire to use a notification approach for notifying at least one Sponsor of the new email address because they both deal with forwarding email to a recipient at a new email address. Furthermore, the teaching of Bliss to require a notification prior to releasing his email address to a requester would allow the user to select which senders will get his new address thus reducing the amount of mail that the recipient would classify as spam (col. 3, lines 9-14).

82. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Schoeffler as applied to claim 24 above, further in view of Chang (US Published Application 2001/0054041).

83. As per claim 30, Reilly fails to explicitly teach the method of claim 24, wherein the step of receiving an old address and a new address from a recipient further comprises establishing a pop-up window on a recipient's web browser, whereupon entry of the old address and the new address into the pop-up window, the old address and the new address are directly communicated to the Network Server.

84. Chang teaches establishing a pop up window for entering changes to the user's profile and transmitting the profile information to a central server for distribution to selected contacts (Paragraph 113).

85. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Chang to receiving

Art Unit: 2154

an old address and a new address from a recipient by establishing a pop-up window on a recipient's web browser and upon entry of the old address and the new address into the pop-up window communicate the old address and the new address to the Network Server of Reilly because they both deal with distributing updates to personal information. Furthermore, the teaching of Chang to use a pop-up window to collect information for transmitting to the central server would allow triggering the collection process when local changes to the user's address are detected thus further automating the update process (Chang, Paragraph 113).

86. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly, Schoeffler and Chang as applied to claim 30 above, further in view of Harari (US Published Application 2002/0016857).

87. As per claim 31, Reilly fails to teach the method of claim 30, wherein the pop-up window further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server.

88. Harari teaches that the data entry field on the web site further comprises a listing of at least two Sponsors from which the recipient may designate at least one Sponsor to receive the old address and the new address from the Network Server (Fig 4, items 403; Paragraphs 0029 and 0030).

89. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Reilly and Harari to provide a web page at the Sponsor with a data entry form allowing the user to designate at

Art Unit: 2154

least one of two or more Sponsors to receive updates address information because they both deal with providing automatic updates to contacts after changing email addresses. Furthermore, the teaching of Harari to allow selecting multiple Sponsors to receive or not receive updated email addresses would allow the recipient to automate the delivery of updated email addresses as the recipient changes addresses (Harari, Paragraphs 0005 and 0023).

90. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and Schoeffler as applied to claim 24 above, and further in view of Official Notice.

91. As per claim 32, Reilly fails to teach the method of claim 24, further comprising requiring a Sponsor, upon receiving the new address, to query the recipient as to whether the recipient desires to receive new messages from the Sponsor at the new address.

92. The Office takes 'Official Notice' that it is well known in the art to provide an opt-in option to request whether a recipient wishes to receive continued communications from a sender. It would have been obvious to one of ordinary skill in this art at the time the invention was made to require a Sponsor upon receiving the recipients address to query the recipient as to whether he desires to receive new messages from the Sponsor because doing so would allow the recipient to reject messages that the recipient would consider to be unwanted.

93. Claims 33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent 6,405,243) in view of Schoeffler (US Published Application 2001/0049745).

94. As per claim 33, Nielsen teaches a method of validating a recipient desires to change an old address to a new address, comprising: receiving a request to register an old address and a new address associated with a recipient (col. 3, lines 52-59); sending a message to each of the old address and the new address, wherein the message notifies the recipient of the change of address request (col. 4, lines 1-12); and updating a database providing change of address information to at least one Sponsor (col. 7, lines 6-13); whereupon receipt of a request from a Sponsor for the new address associated with the old address (col. 4, lines 59-63), the database matches the old address provided by the Sponsor with the old address associated with the recipient and communicates the new address to the Sponsor (col. 5, lines 1-21).

95. Nielsen teaches receiving a response from the old address after an address change, but Nielsen fails to explicitly teach receiving a response from the new address of the change request.

96. Schoeffler teaches receiving a response from the new address of the change request (Paragraph 0045).

97. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Nielsen and Schoeffler because they both deal with forwarding email to a recipient at a new email address. Furthermore, the teaching of Schoeffler to receive a response from the new email address would allow the recipient the opportunity to elect whether the recipient wished to provide the new email address to the requester thus giving the recipient control over the privacy of the email address.

98. As per claim 36, Nielsen teaches the method of claim 33, wherein the old address and the new address are received at an electronic change of address network (col. 3, lines 49-59).

99. As per claim 37, Nielsen teaches the method of claim 33, wherein the message is communicated to the recipient via at least one mailbox selected from the group consisting of: an e-mail mailbox, a voice message mailbox, a pager mailbox, an instant message mailbox, a mobile telephone message mailbox, and a cable message mailbox (col. 4, lines 1-10).

100. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Schoeffler as applied to claim 33 above, further in view of 'Official Notice'.

101. As per claim 34, Nielsen teaches the method of claim 33 including sending a message to the old and new address (col. 4, lines 1-12).

102. Nielsen fails to explicitly teach when the response from the old address is not timely received, communicating a second message to the old address, the second message further informing the recipient of the change of address request.

103. The Office takes 'Official Notice' that it is well known that email delivery systems are not fool proof and that the lack of response to a message is not a guarantee that the message was delivered properly. It would have been obvious to one of ordinary skill in this art at the time the invention was made to resend the message to the old address because doing so would increase the certainty that



the owner of the old address intended to update to the new address thus increasing security.

104. As per claim 35, Nielsen teaches the method of claim 33 including sending a message to the old and new address (col. 4, lines 1-12).

105. Nielsen fails to explicitly teach designating a change of address as an "A" record when a response is received from the recipient via both the old address and the new address and designating the change of address as a "B" record when a response from the old address is not received.

106. The Office takes 'Official Notice' that it is well known that email delivery systems are not fool proof and that the lack of response to a message is not a guarantee that the message was delivered properly. It would have been obvious to one of ordinary skill in this art at the time the invention was made to track addresses where a response from the old address has not been received because these addresses would have lower trust levels since they have lower levels of verification.

***Allowable Subject Matter***

107. Claims 7 and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

108. As per claim 7 and 10, claims 7 and 10 are allowable because the prior art does not suggest individually or in combination a system or method for updating a database containing at least one address for a recipient of an electronic message wherein a reconnection manager queries a Network server for changed

Art Unit: 2154

address, the changed addresses are matched against the those requested by a Sponsor with the matches are communicated to the Network Server which then updates the database.

109. Claims 8, 9 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and addressing the rejection(s) under 35 USC § 112, second paragraph set forth in this office action.

### ***Conclusion***

110. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "System and process for updating electronic messaging accounts".


- i. US 5,493,564 Mullan Address database  
matching one address to a second address for a recipient
- ii. US 6,438,583 McDowell et al. Automatic rerouting  
of email addressed to an old address to a new address
- iii. US 6,615,241 Miller et al. Send automatic  
updates to contacts when an address is updated
- iv. US 2001/0037463 Salta Manage updates for  
address information and send notifications to selected contacts.
- v. US 2001/0047391 Szutu Forward messages  
to new address mapped to a pre-existing identifier

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac R Clark whose telephone number is (571)272-3961. The examiner can normally be reached on Monday-Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irc

 **JOHN FOLLANSBEE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**